

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SAMUEL E. DUNSON
and STAFFORD R. BROOKE III

Appeal No. 95-2221
Application No. 07/994,072¹

ON BRIEF

Before JOHN D. SMITH, GARRIS, and PAK, Administrative Patent Judges.

JOHN D. SMITH Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal pursuant to 35 U.S.C. § 134 from the
final rejection of claims 1-22 and 24.

¹ Application for patent filed December 21, 1992.

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The subject matter on appeal relates to a method for manufacturing a rigid fiber composite material. Claim 1 is representative and is reproduced below:

1. A method for manufacturing a rigid fiber composite material comprising:

(a) needling a three layer composite including a non-woven blend of first fibers and second fibers that is interposed between two interentangled, non-woven layers of the first fibers so that elongate pieces of said two interentangled, non-woven layers of the first fibers are driven into said non-woven blend, said first fibers having a first melting point, said second fibers having a second melting point which is higher than said first melting point, said first fibers comprising greater than ten percent of said non-woven blend; and

(b) heating said three layer composite to a level above melting point of the first thereby forming a plasticized structure and then cooling resulting in the solidification of the two interentangled, non-woven layers of the first fibers and said elongate pieces, said solidification occurring without molding under pressure, heat setting or calendering.

The references of record relied upon by the examiner are:

Parker (Parker)	4,199,635	Apr. 22, 1980
Benedick	4,258,093	Mar. 24, 1981
Adams et al. (Adams)	4,445,954	May 1, 1984
Peoples Jr. (Peoples)	4,568,581	Feb. 4, 1986
O'Connor	4,925,729	May 15, 1990
Serafini	4,935,295	Jun 19, 1990
Schwan	4,971,642	Nov. 20, 1990

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The issues presented for review are:

(1) Whether the examiner correctly rejected the appealed claims under 35 U.S.C. § 112, first paragraph, as based on an original specification which does not provide adequate written descriptive support for the instantly claimed invention;

(2) Whether the examiner correctly rejected claims 1-3, 6, and 10-18 under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103 as obvious over Parker;

(3) Whether the examiner correctly rejected claim 9 under 35 U.S.C. § 103 over Parker in view of Serafini;

(4) Whether the examiner correctly rejected claims 19-22 under 35 U.S.C. § 103 over Parker in view of Adams;

(5) Whether the examiner correctly rejected claim 24 under 35 U.S.C. § 103 as unpatentable over Parker in view of Benedick;

(6) Whether the examiner correctly rejected claims 1-8 and 10-18 under 35 U.S.C. § 103 as unpatentable over Parker in view of Peoples;

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(7) Whether the examiner correctly rejected claims 1-8 and 10-18 under 35 U.S.C. § 103 as unpatentable over Parker in view of Peoples, O'Connor, and Schwan;

(8) Whether the examiner correctly rejected claim 9 under 35 U.S.C. § 103 over Parker in view of Peoples, O'Connor, Schwan, and Serafini;

(9) Whether the examiner correctly rejected claims 19-22 under 35 U.S.C. § 103 as unpatentable over Parker in view of Peoples, O'Connor, Schawn, and Adams;

and

(10) Whether the examiner correctly rejected claim 24 under 35 U.S.C. & 103 as unpatentable over Parker in view of People, O'Connor, Schawn, and Benedick.

We cannot sustain any of the above rejections.

OPINION

With respect to rejection (1), the examiner asserts that the specification fails to provide written descriptive support for the amendatory language in appealed claim 1 regarding the negative limitation that solidification occurs "without molding under pressure, heat setting, or calendaring." We

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have carefully considered the examiner's argument at page 6 of the answer. However, we agree with appellants that the disclosures in the specification at page 1, lines 5-18, particularly lines 14-18; page 7, lines 6-8; and working examples 1 and 2, when read together, reasonably convey that appellants' process is to be carried out "without molding under pressure, heat setting, or calendaring."

The inquiry into whether the description requirement of 35 U.S.C. § 112, first paragraph is met as a question of fact.

In re Wertheim, 541, F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). Whether the description is adequate to support a later claimed invention depends on whether the disclosure of the application originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter. Lack of literal support, in and of itself, is not sufficient to establish lack of adequate descriptive support.

In re Kaslow, 707 F.2d 1366, 1373, 217 USPQ 1089, 1096 (Fed. Cir. 1983). The description requirement of the first paragraph of 35 U.S.C. § 112 may be satisfied if there is

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support in the original disclosure for the concept of what is later claimed. In re Anderson, 471 F.2d 1237, 1244, 176 USPQ 331, 336 (CCPA 1973).

Here, we find the concept that appellants' process does not involve "molding under pressure, heat setting, or calendaring" is reasonably conveyed from the specification as originally filed. Hence, we cannot sustain the examiner's rejection of the appealed claims under 35 U.S.C. § 112, first paragraph, "written description requirement."

We now direct our attention to the prior art rejections before us. Initially we note that the examiner contends that rejections (2), (3), (4), (5), and (6) only apply in the event that "the absence of pressure" is held to be "new matter". Implicit in the examiner's position regarding these rejections is that the negative claim limitation, the subject of the examiner's 35 U.S.C. § 112, first paragraph, written descriptive support rejection, can be ignored in applying the prior art. This approach is untenable as explained in In re Miller 441 F.2d 689, 692, 169 USPQ 597, 600 (CCPA 1971) and In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). As stated by the court in Wilson, 424 F.2d at 1385, 165 USPQ at 496,

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"all words in a claim must be considered in judging the patentability of that claim against the prior art" [emphasis added]. Further, as stated by the Board in *Ex parte Grasselli*, 231 USPQ 393, 394 (Bd. of App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984),

We also note that many of the remaining references required the presence of other elements expressly excluded from the present claims, i.e., halogen, uranium or the co-presence of the vanadium an phosphorus. All of these limitations of the claims must be considered regardless of whether or not they were supported by the specification as filed [emphasis added].

Since it is apparent that the examiner has not given consideration to the negative limitation set forth in the appealed claims, we are constrained to reverse prior art rejections (2), (3), (4), (5), and (6).

Rejections (7), (8), (9) and (10) stand on a different footing. Here, in his statement of the rejections of the appealed claims, the examiner has apparently considered the negative limitation that solidification in appellants' process occurs "without molding under pressure, heat setting or calendaring." Thus, the examiner states in the Answer at pages 12 and 13 that:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to heat above the melting point of the first fibers in the method of Parker in order to provide desired stiffness and rigidity, as taught by Peoples. It further would have been obvious to perform the process without the use of pressure since (1) pressure is not required as shown by O'Connor, and since (2) molding is not necessary where the product is not shaped, as shown by Schwan. The present invention appears to be the product of Parker without a three dimensional shape. Parker and Peoples uses pressure to impart shape to the product. However, if the intended use of the product does not require it to be shaped, one could perform the process without the use of pressure, as shown by O'Connor and Schwan [emphasis added].

We have no doubt that one of ordinary skill in this art "could" have modified Parker's process to exclude the application of pressure, i.e., to exclude molding. However, the examiner has not adequately and persuasively explained why one of ordinary skill in this art would have been led to do so. Indeed Parker is specifically directed to a process for forming decorative shaped products. Thus Parker's process requires shaping or molding, and to achieve this, Parker utilizes a method in which "immediately" after heat treatment, a composite is laminated and press molded into a desired shape. See Parker at column 3, lines 19-36. Thus, producing a product that does not require shaping is inconsistent with

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the goals of Parker's invention. Moreover, the appealed method requires a heat treatment of a three layer composite to form a plasticized structure and "then cooling" to effect the solidification of the non-woven layers. As evident from the disclosure referred to above in Parker, Parker's process does not involve an "immediate" cooling step, after the heating of the composite layers. Indeed, Parker only cools, after the article is shaped by the press molding step.

Accordingly, we cannot sustain rejection (7). Moreover, since the "secondary references" utilized in rejections (8), (9) and (10) do not remedy the basic defects in the examiner's rejection (7), we cannot sustain these rejections.

The decision of the examiner is reversed.

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REVERSED

JOHN D. SMITH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
BRADLEY R. GARRIS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
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CHUNG K, PAK)	
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APJ JOHN D. SMITH

APJ PAK

APJ GARRIS

DECISION: REVERSED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s): 102(b)
103 and 112

Prepared: March 20, 2000

Draft Final

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OB/HD GAU

PALM / ACTS2 / BOOK
DISK (FOIA) / REPORT